

## **REMARKS**

Claims 1-7, 9-18, 20, 31-33 and 35-38 are now pending in the application. Of these pending claims, claims 1, 11 and 12 have been amended; claims 8, 19, 21-30 and 34 have been canceled. The basis for the foregoing amendments may be found throughout the written description, drawings and claims as originally filed. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

### **REJECTION UNDER 35 U.S.C. §112**

Claim 12 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

Applicant has amended claim 12 to replace "said positioning member" with "said positioning rod". Applicant therefore requests reconsideration and withdrawal of this rejection.

### **REJECTION UNDER 35 U.S.C. §102**

Claims 1-20 and 31-38 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 7,255,702 (Serra). This rejection is respectfully traversed.

At the outset, Applicant notes that claim 1 has been amended to include the features of previously submitted dependent claim 8 that was directly dependent upon claim 1. More specifically, Applicant has amended claim 1 to include "a depth selection assembly including a selection portion operably interconnected with said resecting

member to provide an axial depth selection of said resecting member; and a fixable sleeve operably interconnected with said selecting member, such that said selecting member may operably engage said sleeve to select a depth of said resecting member relative to said positioning member". Applicant respectfully submits that the amendment to claim 1 simply incorporates the features of already examined claim 8. Therefore, Applicant submits that the amendment to claim 1 should not necessitate a new search and be entered by the Examiner.

Applicant respectfully submits that each element of amended claim 1 is not disclosed in Serra, and as such, clear error exists in this 35 U.S.C. §102 rejection. It is well settled that "the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office." *In re Skinner*, 2 USPQ 2d 1788, 1788-89 (B.P.A.I. 1986). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992). In *W.L. Gore & Associates v. Garlock, Inc.*, the Federal Circuit stated that "anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It is not enough, however, that the reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention "*arranged as in the claim*". *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

The most recent Office Action is silent on the limitation of a depth selection assembly. Applicant has reproduced Figs. 8 and 11 of Serra immediately below for reference.

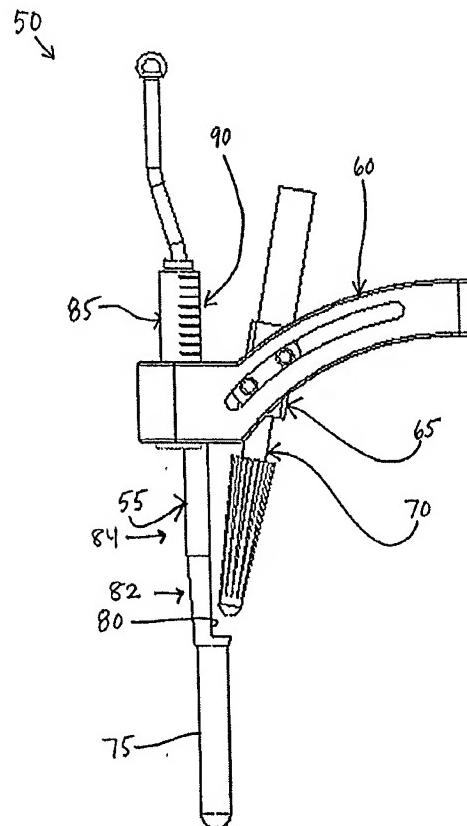


FIG. 8

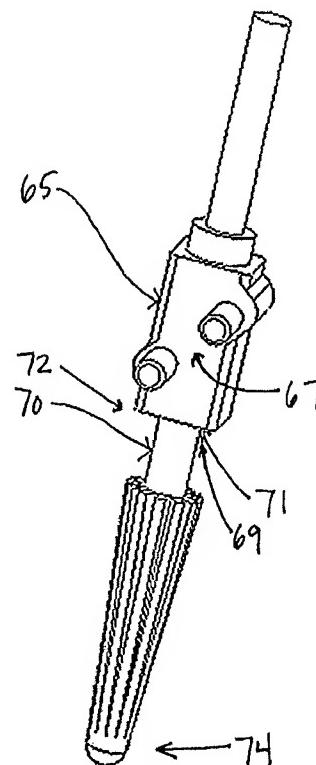


FIG. 11

Serra provides a milling instrument system 50 including a reference frame 55, a guidance support member 30, a reamer shuttle 65, and a cutting device 70. The cutting device 70 is selectively attached to a rotational coupler 71 within the reamer shuttle 65 so that the cutting device 70 is allowed to revolve freely within the reamer shuttle 65 while constrained within a path set by the guidance support member 60. The cutting device 70 and the reamer shuttle 65 are constructed, such that the cutting device 70 is constrained within the reamer shuttle 65 so that only relative motion between each component is the cutting device 70 rotating freely inside the reamer shuttle 65. See

column 5, lines 12-16. During use, the cutting device 70 is constrained within a path set by the guidance support member 60. As the cutting device 70 rotates and follows the path provided by the guidance support member 60, the cavity is created in the bone. Applicant therefore submits that the depth of travel for the cutting device 70 is only controlled by the arcuate path formed in the guidance support member 60. Therefore, Serra does not disclose a depth selection assembly, including "a fixable sleeve operably interconnected with said resecting member, such that said resecting member may operably engage said sleeve to select a depth of said resecting member relative to said positioning member" as required by claim 1. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection as it pertains to claim 1 and dependent claims therefrom.

Turning now to claim 12, Applicant has amended claim 12 to include the features of dependent claim 19 that is directly dependent upon claim 12. Specifically, claim 12 has been amended to include "a depth guide assembly including at least one of: a sleeve adapted to be disposed between said first guiding member and the selected bone portion; and a stop extending from said selecting tool and selectively secured to various positions along said resecting tool operable to engage said guide member upon sufficient translation of said resecting tool and thereby limit movement of said resecting tool relative to said positioning rod". Again, like claim 1 discussed above, claim 12 has been amended simply to include features of already examined claim 19. Therefore, Applicant submits that this amendment to claim 12 should not necessitate a new search and be entered by the Examiner. Applicant notes that the most recent Office Action is silent on the limitations of a depth guide assembly. More specifically, the most recent

Office Action is silent on a depth guide assembly including at least one of a sleeve... and a stop. Therefore, clear error exists in this 35 U.S.C. §102 rejection. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection as it pertains to claim 12 and dependent claims therefrom.

Applicant notes that claim 31 as previously submitted includes "a second guiding assembly... including a depth guide threadably engaged to said resecting tool". Applicant submits that Serra fails to provide a depth guide altogether and more specifically fails to provide a depth guide threadably engaged to a resecting tool as provided in claim 31. As discussed above, Applicant notes that the most recent Office Action is silent on the limitation of a depth guide and more specifically a depth guide that is threadably engaged to the resecting tool. Therefore, clear error exists in this 35 U.S.C. §102 rejection as it pertains to claim 31. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection as it pertains to claim 31 and dependent claims therefrom.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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